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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,880

10/12/2006

John Frankhuisen

784-107

9171

30448

7590

06/24/2009

AKERMAN SENTERFITT

P.O. BOX 3188

WEST PALM BEACH, FL 33402-3188

EXAMINER

WOOD, ELLEN S

ART UNIT

PAPER NUMBER

1794

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,880	<b>Applicant(s)</b> FRANKHUISEN, JOHN	
	<b>Examiner</b> ELLEN S. WOOD	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/06/2009 has been entered.

2. Applicant's arguments, filed 04/06/2009, with respect to claims 1-22 have been fully considered and are persuasive. The rejection of claims 1-22 under 35 U.S.C. 103(a) as being unpatentable over Keller et al. (US 5,691,043) has been withdrawn.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

In regards to claim 8, the applicant claims **“the label is attached to the outer surface of a container by a glue which is applied to the label when wet and allowed to dry when in situ on the container.”** The specifications state that "the resulting product can then be attached to a bottle 1, or other container, by way of a glue 6" (pg. 5 lines 6-7). There is no description of the glue being applied to the label when wet and allowed to dry in situ on the container.

In regards to claims 13, the applicant claims **“wherein the under layer is a five layer extruded film.”** However, there is no description of the five layers within the specifications. The drawings only supply two layer films for the under layer. Thus, the invention was not described in the specification in such a way as to reasonably convey to one skilled in the art.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the under layer that is a five layer extruded film as claimed in claim 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New

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Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6, 8, 10, 22 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regards to claim 6, the claim states ***“the inner layer provides an innermost surface adapted to facilitate adhesion to an outer surface of a container”***. The claim is dependent from claim 5, wherein claim 5 is dependent from claim 1. In both claims 1 and 5 only an inner layer and an under layer have been claimed. Is the applicant referring to the under layer?

In regards to claim 8, the applicant claims ***“the label is attached to the outer surface of a container by a glue which is applied to the label when wet and allowed to dry when in situ on the container.”*** Is the glue a wet-based adhesive? Is the glue applied to a label that is wet and then it is dried on the container? The examiner considers the glue to be a wet-based adhesive. Claim 22 is rejected as being a dependent from claim 8.

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In regards to claim 10, the applicant claims **“the plastics material is at least one of the group consisting of biaxial polyethylene, non-orientated polypropylene and PET.”** The claim is dependent from claim 1, wherein claim 1 does not claim a plastics material.

In regards to claim 11, the applicant claims **“biaxial polypropylene plastic.”**  
Does this refer to biaxial orientated polypropylene?

In regards to claim 24, the applicant claims **“wherein the outer layer is paper”**.  
The claim is dependent from claim 18 which is dependent from claim 16. Claim 16 claims an outermost layer but does not describe an outer layer. Does the "outer layer" comprise a multi-layer laminate? Where is the outer layer positioned within the laminate?

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 4-11 and 15-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Samonides (WO 91/16025).

In regards to claims 1 and 23, Samonides discloses a pre-printed label. The label consist of a carrier sheet (outer layer), may be a white kraft paper (pg. 13 ¶1). Thus, the under layer has an opacity. A transparent face sheet (under layer) is extruded onto the

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carrier sheet (pg. 13 ¶3). The face sheet has been described as transparent but the film may be opaque (pgs. 14-15 ¶3). It would be inherent that when a paper layer is exposed to moisture or liquid the opacity would reduce, however when a polyolefin is exposed to moisture or liquid the opacity would retain, because paper absorbs moisture or liquid, wherein polyolefin materials repel moisture or liquid.

In regards to claims 2, Samonides discloses that the face sheet is adhered to the carrier sheet and the face sheet being a film of plastics (pg. 13 ¶3).

In regards to claim 4, Samonides discloses that the carrier sheet is secured to the face sheet by a permanent adhesive (pg. 13 ¶3).

In regards to claim 5, Samonides discloses that the face sheet is a stable laminate base (pg. 4 ¶1).

In regards to claims 6-7, Samonides discloses that the first or bottom surface of the pressure-sensitive adhesive layer may be adhesively affixed to another surface, such as the surface of a container or the like (pg. 4 ¶4). The examiner considers this the innermost surface.

In regards to the claim 8, Samonides discloses a label attached to the outer surface of a container by a glue which is applied to the label when wet and allowed to dry when in situ on the container (pg. 5 ¶2).

In regards to claims 9 and 22, Samonides discloses that the container is a clear bottle (pg. 1 ¶2).

In regards to claims 10-11, Samonides discloses that the face sheet is formed of a polyester resin, or polypropylene, or polyethylene (pg. 13 ¶3).

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In regards to claim 15, Samonides discloses that the face sheet is extruded on top of the printing, and the composite is then pressed between form rolls (pg. 13 ¶3). The outer layer is being joined to the under layer onto a sheet of extruded plastics material.

In regards to claims 16-17, Samonides discloses an outermost label wherein a pressure sensitive adhesive layer has printed label indicia which is then covered by a thermoplastic protective cover (pg. 4 ¶1). The pressure-sensitive adhesive layer is applied to smooth surface, such as a bottle (pg. 4 ¶1), thus, an innermost layer that is coupled between the outermost layer and the bottle. The protective cover and the adhesive may be an opaque material (pg. 15 ¶1).

In regards to claim 18, Samonides discloses that the pressure-sensitive adhesive is preferably a water-based, acrylic adhesive and may be colorless or tinted (pg. 10 ¶4). The formula for the acrylic adhesive includes acrylate polymer (pg. 10 ¶4), thus a plastics material.

In regards to claims 19-20, Samonides discloses the laminate formed through extrusion (pg. 14), which is a water insoluble means and fusion of plastics material.

In regards to claim 21, Samonides discloses that the label has a pressure-sensitive adhesive layer, preferably a water-based acrylic adhesive (pg. 3 ¶ 3). Printed label indicia is applied to the pressure-sensitive adhesive layer and a thermoplastic protective cover layer covers the printed indicia and is irremovably affixed to the second or top surface of the pressure-sensitive adhesive layer, which is the surface carrying the printed label indicia (pg. 4 ¶ 1). The first or bottom surface of the pressure-sensitive



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adhesive layer may be adhesively affixed to another surface, such as the surface of a container or the like, and the printed indicia will be visible (pg. 4 ¶ 1).

In regards to claim 24, Samonides discloses a carrier sheet 4 that consists of a white kraft paper (pg. 13 ¶1). This is considered an outer layer of paper (fig. 2).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Samonides (WO 91/16025).

Samonides discloses the label of laminate construction as previously discussed. Smith is silent with regards to the under layer being white and the level of opaqueness of the polypropylene plastic.

Samonides discloses that a transparent face sheet (under layer) is extruded onto the carrier sheet (pg. 13 ¶3). The face sheet has been described as transparent but the film may be opaque (pgs. 14-15 ¶3) so that the label indicia which has been printed on the adhesive layer at the interface with the face sheet is visible through the adhesive and through the underside of the label (pg. 15 ¶3). This is desirable where the label is applied to a clear bottle (pg. 15 ¶3).

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It would be obvious to one of ordinary skill in the art to use a white face sheet and an appropriate level of opaqueness of the white face sheet when applying the label to a glass bottle, because the white face sheet and level of opaqueness provides the printed indicia to appear when the label is wet.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELLEN S. WOOD whose telephone number is (571)270-3450. The examiner can normally be reached on M-F 730-5 with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rena L. Dye/  
Supervisory Patent Examiner, Art Unit 1794